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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,546	06/22/1999	SHIGEKI HIROOKA	35.G2410	9128

5514 7590 12/28/2005

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EXAMINER

NEURAUTER, GEORGE C

ART UNIT PAPER NUMBER

2143

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Art Unit: 2143

**DETAILED ACTION**

Claims 1, 2, 8, 10-16, 22, 24-30, 36, and 38-40 are currently presented and have been examined.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 September 2005 has been entered.

***Response to Arguments***

Applicant's arguments filed 19 September 2005 have been fully considered but they are not persuasive.

The Applicant has argued that Tso does not teach the limitations of the claims. The Examiner is not persuaded by these arguments. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Tso discloses:

Art Unit: 2143

"Embodiments of the present invention provide the ability to dynamically transcode information transmitted between, for example, a network server computer and a network client computer. As used herein, the term "transcode" applies to virtually any manipulation of data including, but not limited to, adding, modifying or deleting data." (column 2, lines 44-49)

"As noted above, parser 22 may selectively invoke one of transcode service providers 24 based upon satisfaction of a predetermined selection criterion. Such selection criterion may comprise, for example, information contained in a header portion of a data packet received by transcoding server 34, such as a MIME type, a URL (Uniform Resource Locator), a last modified time indicator and so on." (column 6, line 64-column 7, line 7)

In view of the Examiner's positions presented previously, the Examiner maintains that Tso does disclose these limitations when in combination with the teachings of "RFC 1521". The deletion of data occurs when the packet of data is "transcoded" as disclosed in Tso. The data is stored when the transcoded data arrives at its destination.

The Examiner also impresses that the claims employ broad language such as "can be processed" or "cannot be processed". These broad limitations used in conjunction with either "storing" or "deleting" data have a plurality of interpretations

Art Unit: 2143

and embodiments such as checking for corrupt data or filtering data based on predetermined selection criteria including user preferences, virus detection, and maximum transfer size for the data in accordance with the Examiner's broadest reasonable interpretation. It is suggested that, in order to place the claims in better condition for allowance, that these limitations be amended in order to further define the invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 2143

Claims 1-2, 8, 10-16, 22, 24-30, 36, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6 421 733 B1 to Tso et al in view of "Request for Comments 1521: MIME (Multipurpose Internet Mail Extensions) Part One" ("RFC 1521").

Regarding claim 1, Tso discloses a processing method comprising the steps of:

first identifying whether a received packet is a multi-part packet based on a header of the received packet; (column 6, line 64-column 7, line 7)

second identifying a data type of each part included in a text of the received packet, when it is identified in said first identifying step that the received packet is a multi-part packet ("MIME"); (column 10, lines 37-49, specifically lines 37-44)

determining whether each part included in the received packet can be processed, by comparing the identified data type of each part with a registered utilizable data type; storing a part that can be processed, included in the received packet, if it is determined in said determining step that the part can be processed (column 10, lines 37-49, specifically lines 44-49); and

deleting a part that cannot be processed, included in the received packet, if it is determined in said determining step

Art Unit: 2143

that the part cannot be processed. (column 2, lines 44-49; column 10, lines 37-49, specifically lines 44-49).

Tso does not expressly disclose wherein the method uses e-mail, however, Tso does disclose that the method uses MIME to perform the invention (column 6, lines 37-41).

"RFC 1521" discloses that MIME is used in conjunction with e-mail (page 1, Abstract, paragraph beginning "STD 11, RFC 822 defines a message..." and paragraph beginning "In particular, this document...").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tso to use email as disclosed in "RFC 1521" within the context of the steps disclosed. "RFC 1521" discloses that MIME enables e-mail to be reformatted to allow text and non-text e-mail parts to be sent together without losing any information (page 1, Abstract, paragraph beginning "STD 11, RFC 822 defines a message...", lines 3-5 and paragraph beginning "In particular, this document...") In view of the specific advantages disclosed in "RFC 1521" regarding the use of MIME and wherein both references disclose the use of MIME, one of ordinary skill would have appreciated the specific advantages disclosed in "RFC 1521" and would have found it obvious to modify Tso to accomplish the

Art Unit: 2143

method disclosed in Tso using e-mail as disclosed in "RFC 1521" based on the specific references to MIME in both references.

Regarding claim 2, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses the method further comprising the step of: registering data types that can be processed, in advance, wherein it is determining step that a part can be processed when the identified data type of the part coincides with a registered data type ("predetermined selection criterion"; column 7, line 15-column 8, line 9, specifically column 7, lines 43-54; column 10, lines 37-49, specifically "...interrogating a MIME type in the content-type header record...if parser 22 detects a method for a predetermined selection criterion...").

Regarding claim 8, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein a presence of a part that cannot be processed is notified to a user (column 8, line 51-column 9, line 10, specifically column 9, lines 7-10).

Regarding claim 10, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein, when it has been determined that a part cannot be processed, a subsequent process is selectable from a plurality of predetermined processes. (column 7, line 15-



Art Unit: 2143

column 8, line 9, specifically column 7, lines 43-54; column 10, lines 37-49, specifically lines 44-49)

Regarding claim 11, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein a data type of a part that can be processed is a text. ("content type"; column 10, lines 37-49, specifically lines 37-44)

Regarding claim 12, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein a data type of a part that can be processed is an image. ("content type"; column 10, lines 37-49, specifically lines 37-44)

Regarding claim 13, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein identification of a data type is performed by analyzing the received packet. (column 10, lines 37-49, specifically lines 37-44)

Tso does not disclose wherein the method uses e-mail.

Claim 13 is rejected since the motivations regarding the obviousness of claim 1 also apply to this claim.

Regarding claim 14, Tso and "RFC 1521" disclose a method according to claim 1.

Art Unit: 2143

Tso discloses wherein a data type of a part is identified in said identifying step according to a reference character string specified based on a position of a predetermined character string in the received email ("content-type header record"; column 10, lines 37-49, specifically lines 37-44).

Claims 15-16, 22, and 24-28 are rejected since these claims recite an apparatus that contain substantially the same limitations as recited in claims 1-2, 8, and 10-14 respectively.

Claims 29-30, 36, and 38-40 are rejected since these claims recite a computer-readable storage medium storing control software that contain substantially the same limitations as recited in claims 1-2, 8, and 10, and 13-14 respectively.

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2143

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